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OFFICE OF PETITIONS

In re Patent No. 7,122,655 :
Mendelsohn et al. : DECISION ON REQUEST FOR
Issue Date: October 17, 2006 : RECONSIDERATION OF
Application No. 10/715,632 : PATENT TERM ADJUSTMENT
Filed: November 17, 2003 :
Atty Docket No. 00398/518002 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed December 13, 2006. Patentees request that the patent term adjustment indicated on the patent be corrected from one hundred twelve (112) days to two hundred thirty-two (232) days.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On October 17, 2006, application No. 10/715,632 matured into Patent No. 7,122,655. The instant request for reconsideration filed December 13, 2006, was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 112 days. The PTA of 232 days was reduced by 120 days pursuant to 37 CFR § 1.704(c)(10) for the submission of drawings after the mailing of the notice of allowance.

There is no dispute that drawings were filed on May 10, 2006 after the mailing of the notice of allowance on July 7, 2005. However, patentees argue that no reduction is warranted for the filing of these drawings as they were filed in response to a Notice and the Notice was the first request for formal drawings and Applicants promptly replied. Furthermore, during prosecution, applicants filed a Petition to Accept Color Drawings and replacement copies of Figures 2D and 6B in response to an Office Notice. Furthermore, the Office subsequently issued a Notice of Allowability on July 7, 2005, in which the drawings filed on November 17, 2003 were accepted. Finally, applicants submit that compliance with the Notice after payment of the issue fee was not a failure to engage in reasonable efforts to conclude prosecution, as the Office expressly indicated to Applicants during prosecution that the drawings were acceptable.

Patentees' arguments have been considered, but are not persuasive. The filing of drawings after the mailing of a Notice of Allowance is properly a basis for reduction of patent term adjustment.

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office. Filing of any drawings after allowance will be

treated as a failure to engage in reasonable efforts to conclude prosecution.

Moreover, it is undisputed that patentees never disputed the accuracy of the Notice requiring drawings. Further, such drawings were required by the regulations. See 37 CFR 1.84. For example, the views of the drawings were not labelled separately or properly (i.e., "Figure 2A" and "Figure 2B" were labelled jointly as Figure 2 with an A and a B associated with each). No notice from the Office was required for applicants to be aware that their drawings failed to be in compliance with 37 CFR 1.84.

In order to avoid this failure to engage in reasonable efforts to conclude prosecution of the application, patentees should have filed formal drawings in compliance with 37 CFR 1.84(p)(5) prior to the mailing of the notice of allowance, instead of waiting for a notice from the Office. The drawings filed November 17, 2003 were formal but did not in compliance for issuance of the patent. (The replacement drawing sheets filed May 21, 2004 did not correct this deficiency).


Accordingly, pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by the lesser number of days, 120, counting the number of days in the period beginning on the date the drawings were filed, May 10, 2006, and ending on the date of issuance of the patent, October 17, 2006.

In view thereof, the reduction of 120 days was proper.

It is concluded that the patent properly issued with a revised Patent Term Adjustment of eleven (112) days.

Receipt is acknowledged of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this decision may be directed to the undersigned at (571) 272-3219.



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